

REMARKS

Claims 26-51 are pending; claims 39-51 are withdrawn; claims 26-38 are rejected, and claim 38 is objected to in this application. Claims 26, 27, 32, 36, and 38 are amended; claim 31 is canceled, and claim 52 is added hereby. Claim 52 has been added to further protect Applicants' valuable intellectual property and this claim largely reflects the allowable claim in corresponding European Application 1711657 A1, which relates to PCT/EP2004/053630. This new claim is added without adding any new matter thereby.

Responsive to the rejection of claim 38, Applicants have amended claim 38, incorporating the suggestions of the Examiner. For the foregoing reasons, Applicants submit that claim 38 is now in allowable form and respectfully request the withdrawal of the objection thereto.

Responsive to the rejection of claims 27, 31, 32, and 36 under 35 USC § 112, second paragraph, Applicants have amended claims 27, 32, and 36 and canceled claim 31. The amending of claims 27, 32, and 36 were undertaken to eliminate confusion noted by the Examiner in the Office Action. For the foregoing reasons, Applicants submit that claims 27, 32, and 36 are now in condition for allowance, the allowance of which being hereby respectfully requested.

Responsive to the rejection of claims 26-29, 31-34, and 37 under 35 USC § 103(a) as being unpatentable over International Publication WO 02/103109 (Korhonen) in view of US Patent Application Publication No. 2003/0178165 (Bobsein, et al.), Applicants have amended claim 26 and canceled claim 31 and submit that claims 26-29, 32-34, and 37 are now in condition for allowance.

Korhonen discloses a method for the manufacture of LWCR printing paper that is coated once. There is a pre-calender 500, a coating station 600, and a drying section 700 (abstract and page 23, lines 1-11). The LWCR printing paper can be manufactured by film coating method or non-contact coating method. The PPS-s10 roughness of the base paper shall be below 3.5 μm (column 4, lines 1-14).

Bobsein, et al. disclose a paper having an improved print quality and method of making the same including having a sheet gloss, as defined in table 3, of approximately 30% (paragraph 54 and 62).

In contrast, claim 26 as amended, recites in part:

said roughness level and said gloss value in combination having values that lie within a triangularly shaped region defined by a first point, a second point, and a third point, said first point being 0.8 μm roughness level and 3% gloss value, said second point being 0.8 μm roughness level and 35% gloss value, said third point being 3.9 μm roughness level and 3% gloss value.

(Emphasis added). Applicants submit that such an invention is neither taught, disclosed, nor suggested by Korhonen, Bobsein, et al. or any of the other cited references, alone or in combination, and includes distinct advantages thereover.

Korhonen discloses a method for the manufacture of LWCR printing paper that is coated once and has a PPS-ST roughness below 3.5 μm . Bobsein, et al. disclose a paper having a sheet gloss of approximately 30%. Applicants have amended the claim to specifically claim a combination of quality and roughness that lies within a triangular range as discussed in page 9 of the specification as originally filed and as illustrated in Fig. 4. Applicants' invention surprisingly accomplishes a combination of gloss and roughness that is not obtained by other methods. Furthermore, it is the combination of the two qualities that establish Applicants' method as producing a paper with two desirable qualities in a range accomplished by the steps outlined in the independent claim. Therefore, Korhonen, Bobsein, et al., and any of the other cited references, alone in combination, fail to teach, disclose, or suggest a roughness

level and a gloss value in combination having values that lie within a triangularly shaped region defined by a first point, a second point, and a third point, the first point being 0.8 μm roughness level and 3% gloss value, the second point being 0.8 μm roughness level and 35% gloss value, and the third point being 3.9 μm roughness level and 3% gloss value, as recited in claim 26.

The present invention has several advantages, including the ability to produce paper with a combination roughness and gloss value that is uniquely obtained by the steps of the method utilized by Applicants. For the foregoing reasons, Applicants submit that claim 26, and claims 27-29, 32-34, and 37 depending therefrom, are now in condition for allowance, the allowance of which being hereby respectfully requested.

Claims 30, 35, 36, and 38 have been rejected under 35 USC § 103(a) as being unpatentable over Korhonen and Bobsein, et al., and in further view of US Patent Application Publication No. 2002/0117277 (Johnson, et al.). However, these claims depend from claim 26, which is now in condition for allowance for the reasons given above. Accordingly, Applicants submit that claims 30, 35, 36, and 38 are now in condition for allowance, the allowance of which being hereby respectfully requested.

For the foregoing reasons, Applicants submit that the pending claims are definite and do particularly point out and distinctly claim the subject matter which Applicants regard as the invention. Moreover, Applicants submit that no combination of the cited references teaches, discloses or suggests the subject matter of the amended claims. The pending claims are therefore in condition for allowance, and Applicants respectfully request withdrawal of all rejections and allowance of the claims.

In the event Applicants have overlooked the need for an extension of time, an additional extension of time, payment of fee, or additional payment of fee, Applicants hereby conditionally

petition therefor and authorizes that any charges be made to Deposit Account No. 20-0095,

TAYLOR & AUST, P.C.

Should any question concerning any of the foregoing arise, the Examiner is invited to telephone the undersigned at (260) 897-3400.

Respectfully submitted,

/Max W. Garwood, Reg. No. 47589/

Max W. Garwood
Registration No. 47,589

Attorney for Appellant

MWG/lb/bd

Electronically filed March 12, 2010

TAYLOR & AUST, P.C.
142 S. Main Street
P.O. Box 560
Avilla, IN 46710
Telephone: 260-897-3400
Facsimile: 260-897-9300